

Applicants: Watson et al.  
Serial No.: 10/826,785  
Filing Date: April 16, 2004  
Docket No.: ZIL-308-1C

### REMARKS

Reconsideration and allowance are respectfully requested.

Before entry of this amendment, claims 1-9 and 14-17 were pending. Claims 1-13 were originally filed. In a preliminary amendment, claims 10-13 were canceled, claims 1-3, 5-9 were amended, and claims 14-17 were added. The preliminary amendment was apparently overlooked because claims 1-13 were rejected in the Office Action. In the present amendment, claims 1-9 are amended, claims 14-17 are canceled and claims 18-29 are added. After entry of the amendment, claims 1-9 and 18-29 are pending.

#### I. Claims 1-13

Claims 1-13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kimura (US Patent No. 6,211,797) (Office Action, p. 2, lines 10-11). Applicants respectfully disagree and traverses the § 103(a) rejection.

To establish a *prima facie* case of obviousness, the Examiner must demonstrate at least that the prior art reference teaches or suggests all of the claim limitations. In limited circumstances, it is appropriate for an examiner to take official notice of facts not in the record or to rely on "common knowledge" in making a rejection.

#### A. Independent claims 1, 5, 18 and 26

Each of independent claims 1, 5, 18 and 26 recites the configuration of an application in a second device. Claims 1 and 5 each recite, "wherein the communication contains instructions from an application set in the peripheral device". Claims 18 and 26 recite, "wherein the second device contains an application having a configuration". In one embodiment, the second device is a printer, and the application is a software program for executing a function of printing on the second device.

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Kimura does not form the basis for a valid rejection of claims 1, 5, 18 and 2x under § 103(a) because Kimura does not teach or suggest all of the claim elements. Specifically, Kimura does not teach an application with a configuration.

The Examiner cites column 7, lines 1-12, of Kimura as teaching the detecting of the configuration of the application. The Examiner states, "a detector for detecting the configuration of a second said device (see col. 7, lines 1-12; the received information inputted through the communication port contain configuration of the second device, therefore there must be a detector to detect the signal and information within the signal such as configuration of another device)" (Office Action, page 2, lines 16-19)\*. The Examiner continues, "Since modulation/demodulation is application or device specific (for example, one device's modulation technique may vary from other device's modulation technique; such device may be identified by difference ID or versions), therefore it would have been obvious to consider the modulation/demodulation as the application set group" (Office Action, page 3, lines 1-5) (emphasis added).

The apparatus of Kimura for selecting modulation/demodulation schemes, however, is unrelated to the application recited in claims 1, 5, 18 and 26. The application recited in claims 1, 5, 18 and 26 can be a software program for executing a function on a peripheral device, such as printing. The infrared protocol selector of Kimura does not relate to software programs that reside in the memory of the device and that communicate with a wireless transceiver in order to send instructions to a peripheral device.

The apparatus of Kimura switches between modulation/ demodulation

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\* To the extent that claim limitations, e.g., a detector, are not taught in the cited reference, the Examiner is asked to indicate that he is taking official notice of facts not in the record or relying on common knowledge to find the claim limitation that is not taught by the cited reference.

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schemes in order to enable communication. Without the infrared protocol selector of Kimura, communication would otherwise not be possible. Kimura states:

"An application program, therefore, is required to switch an infrared modulation/demodulation scheme to an infrared modulation/demodulation scheme employed by a communication unit of the other party before conducting data communication using an infrared unit. As a result, the user is required to consider the infrared modulation/demodulation scheme of the communication unit of the other party, and unless an infrared modulation/demodulation scheme employed by the user suits that of the communication unit of the other party, the user is unable to conduct data communication" (Kimura, col. 2, lines 7-17) (emphasis added).

The modulation/demodulation schemes of Kimura relate to establishing communication, whereas the "application" recited in claims 1, 5, 18 and 26 is not used to establish a communication connection. Instead, instructions of the application are communicated between the device and the peripheral device once wireless communications have been established. The specification states, "it should be understood that Ir communications 14 may be possible between a certain pair if [sic] appliances even if the app sets do not match. However, since the app sets may not 'understand' one another, some or all of the desired functionality might be lost or may produce erroneous operations" (Specification, page 7, lines 4-8).

Because Kimura does not disclose all of the elements of claims 1, 5, 18 and 26, Kimura does not form the basis for a valid rejection under § 103(a). Reconsideration of the § 103(a) rejection of claims 1 and 5, and allowance of claims 1, 5, 18 and 26 are requested.

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B. Dependent claims 2-4

Claim 2 recites an optimum application set. The Examiner suggests that Kimura teaches an application set that is selected for optimum performance. (Office Action, p. 3, lines 7-10) Any performance disclosed in Kimura would relate to the performance of the infrared communication link. "Optimum" as recited in claim 2 relates to the optimum functionality of the function (such as printing) provided by the application set, and does not relate to the optimum performance of the communication link.

In addition, claims 2-4 depend from claim 1 and are allowable for at least the same reasons for which claim 1 is allowable. The rejection of claim 12 should therefore be withdrawn. Allowance of claims 12-14 and 21 is requested.

C. Dependent claims 6-9

Claims 6-9 depend from claim 5 and are allowable for at least the same reasons for which claim 5 is allowable. Allowance of claims 6-9 is requested.

II. New claims 18-29

Applicants are adding new claims 18-29, each of which is supported by the specification and allowable over the cited reference. No new matter is added.

III. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully submit that the entire application (claims 1-9 and 18-29) is in condition for allowance. Applicants respectfully request that a timely Notice of Allowance be

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issued in this case. The undersigned can be contacted at (925) 621-2121 to discuss any aspect of this application.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

By   
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Date of Deposit: September 27, 2005

Respectfully submitted,



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